

REMARKS

Claims 1-6, 8-13 and 47-54 are pending in this application. No amendment is made.

Claims 1, 3, 4, 8-13 and 47-52 stand rejected under 35 USC 103(a) over Kidwell in view of McCormick. In particular, the Examiner stated that the combination of Kidwell and McCormick would inherently result in the claimed invention.

According to the Federal Circuit in *In re Robertson*, 169 F.3d 743, 745; 49 USPQ2d 1949, 1950-1951 (Fed. Cir. 1999):

To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is ***necessarily*** present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.

As explained by the Federal Circuit in *In re Robertson*, to make an inherency argument, the Examiner has to rely on a missing element that would be ***necessarily*** present in the thing described in the reference.

In the Action, the Examiner stated that, even though Kidwell and McCormick do not disclose the claimed SERS signal enhancement, the enhancement is an inherent property of the metallic colloid. Applicants claim a metallic colloid that includes both a metal and an organic molecule. As explained in the specification, both the metal ***and*** the organic molecule contribute to producing a Raman signal enhancement that is greater than the enhancement provided by a silver colloid prepared by a titration method as claimed. Neither Kidwell nor McCormick discloses or suggests utilizing a metallic colloid with the specific organic molecules disclosed in Applicant's specification. Accordingly, the claimed Raman signal enhancement would not necessarily result from the metal particles disclosed in Kidwell or McCormick.

Claim 2 stands rejected under 35 USC 103(a) over Kidwell in view of McCormick and further in view of Albrecht. Claim 2 depends from claim 1. As stated above, there is no evidence that the claimed Raman signal enhancement would be inherently present in the combination of Kidwell and McCormick. Since Albrecht does not fill the gaps in Kidwell and McCormick, Applicants respectfully request that this rejection be withdrawn.

Claim 5 stands rejected under 35 USC 103(a) over Kidwell in view of McCormick and further in view of Smith. Claim 5 depends from claim 1. As stated above, the claimed Raman signal enhancement is not inherently disclosed in Kidwell and McCormick. Since Smith does not fill the gaps in Kidwell and McCormick, Applicants respectfully request that this rejection be withdrawn.

Claim 6 stands rejected under 35 USC 103(a) over Kidwell in view of McCormick and further in view of Strohmaier. Claim 6 depends from claim 1. As stated above, the claimed Raman signal enhancement is not inherently disclosed in Kidwell and McCormick. Since Strohmaier does not fill the gaps in Kidwell and McCormick, Applicants respectfully request that this rejection be withdrawn.

Claims 1, 3, 4, 8-13 and 47-54 stand rejected under 35 USC 103(a) over Kidwell in view of Reda. The Examiner stated that combining Kidwell's metallic colloid to Reda's organic molecules would inherently result in the claimed Raman signal enhancement since the enhancement is inherent to the metallic colloids. Reda discloses using cystamine with an aqueous solution of gold nano particles at paragraph [0068] as the Examiner pointed out. However, the cystamine disclosed in that paragraph is used to cross-link the nanoparticles, not to bind the metallic colloid to the biomolecules as claimed. Thus, neither Kidwell nor Reda discloses or suggests utilizing a metallic colloid with the organic molecules to enhance the Raman signal of biomolecules as claimed. Accordingly, the claimed Raman signal enhancement would not *necessarily* result from the metal particles disclosed in Kidwell or Reda, and Applicants respectfully request that this rejection be withdrawn.

In view of the above, each of the presently pending claims in this application is in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue. If it is determined that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number given below.

In the event the U.S. Patent and Trademark office determines that an extension and/or other relief is required, Applicants petition for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to Deposit Account No. 03-1952 referencing docket no. 070702003400. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

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Respectfully submitted,

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